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TO:　**MAIL STOP APPEAL BRIEF – PATENTS**
　　　Commissioner for Patents
　　　United States Patent and Trademark Office

　　Fax No. 571-273-8300　　　　Phone No.

FROM: Ineke Sweeney

　　Fax No. 513-634-3612　　　Phone No. 513-634-4277

Application No.:　10/619,656

Inventor(s):　　Hilbig, et al.

Filed:　　　　July 15, 2003

Docket No.:　　CM2504RQ

Confirmation No.: 7175

FACSIMILE TRANSMITTAL SHEET AND

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8

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1) Appeal Brief

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(FAX-USPTO.doc Revised 11/18/2005)

PTO/SB/17 (1-06)
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL **for FY 2006** Patent fees are subject to annual revision. Effective December 8, 2004	**Complete if Known**	
	Application Number	10/619,656
	Confirmation Number	7175
	Filing Date	July 15, 2003
	First Named Inventor	Hilbig
	Examiner Name	J. A. Fortuna
	Art Unit	1731
TOTAL AMOUNT OF PAYMENT ($500.00)	Docket No.	CM2504RQ

METHOD OF PAYMENT

1. [X] The Director is hereby authorized to charge indicated fees submitted on this form, credit any over payments, and charge any additional fee(s) during the pendency of this application to:

Deposit Account Number: 16-2480
Deposit Account Name: **The Procter & Gamble Company**

FEE CALCULATION

2. BASIC FILING FEE – Large Entity

Application Type	FILING FEE	SEARCH FEE	EXAMINATION FEE	Fee Paid
Nonprovisional Utility	($300)	($500)	($200) (Total = $1000)	[]
Design	($200)	($100)	($130) (Total = $430)	[]
Reissue	($300)	($500)	($600) (Total = $1400)	[]
Provisional Utility filing fee			(Total = $200)	[]

3. APPLICATION SIZE FEE:

Sheets of Spec and Drawings   []
($250 for each 50 sheets in excess of 100, except for sequence and program listings)

SUBTOTAL (2)+(3)   ($)[]

4. EXTRA CLAIM FEES FOR UTILITY AND REISSUE:

	Extra Claims	Fee from Below	Fee Paid
Total Claims	[] - 20** = [] x	[] =	[]
Independent Claims	[] - 3** = [] x	[] =	[]
Multiple Dependent claims:		[] =	[]

** or number previously paid, if greater; For Reissues, see below

Fee Description
Claims in excess of 20 ($50 per claim)
Independent claims in excess of 3 ($200 per claim)
Multiple dependent claim, if not paid ($360)
**Reissue: each independent claim over 3 and more than in the original patent ($200 per claim)
**Reissue claims: each claim over 20 and more than original patent ($50 per claim)

SUBTOTAL (4)   ($)[]

FEE CALCULATION (continued)

5. ADDITIONAL FEES

Fee Description		Fee Paid
Extension for reply within 1st month	($120)	[]
Extension for reply within 2nd month	($450)	[]
Extension for reply within 3rd month	($1,020)	[]
Extension for reply within 4th month	($1,590)	[]
Extension for reply within 5th month	($2,160)	[]
Information Disclosure Statement fee	($180)	[]
37 CFR 1.16(f) Late Oath/Declaration (nonprovisional)	($130)	[]
37 CFR 1.17 (q) Surcharge - Late provisional filing fee or cover sheet	($50)	[]
Non-English specification	($130)	[]
Notice of Appeal	($500)	[]
Filing a brief in support of an appeal	($500)	[X]
Request for oral hearing	($1,000)	[]
Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)	($1,370)	[]
Other: _____		[]

SUBTOTAL(5)   ($) [500]

SUBMITTED BY

Name (Print/Type)	Peter D. Meyer	Registration No. (Attorney/Agent)	47,792	Complete (if applicable)	
				Telephone	(513) 634-7419
Signature				Date	September 28, 2006

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon individual case. Any comments on the amount of time you are required to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P. O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Fee Transmittal.doc (Revised for P&G use 04/25/2006)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	10/619,656
Inventor(s)	:	Hilbig, et al.
Filed	:	July 15, 2003
Art Unit	:	1731
Examiner	:	J. A. Fortuna
Docket No.	:	CM2504RQ
Confirmation No.	:	7175
Customer No.	:	27752
Title	:	LOTIONED AND EMBOSSED TISSUE PAPER

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA   22313-1450
Dear Sir,

This is Appellants' Brief relating to an appeal from the May 9, 2006 Final Rejection in the above-identified Application. The Notice of Appeal was deposited with a Certificate of Facsimile transmission and addressed to Commissioner for Patents, Alexandria, VA 22313-1450 on August 9, 2006, and was noted as received by the U.S. PTO on August 9, 2006.

I. Real Party in Interest

The real party in interest for the present Application S.N. 10/619,656 is The Procter & Gamble Company of Cincinnati, OH by virtue of the Assignment recorded on November 4, 2003, at Reel No. 014152, Frame 0340.

II. Related Appeals and Interferences

There are no related appeals or interferences known to Appellants' undersigned legal representative, which will directly affect, or be directly affected by or have a bearing on, the Board's decision in the present appeal.

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III. Status of Claims

In the Notice of Appeal, Appellants appealed the final rejection of all pending Claims 1-7. The complete copy of the appealed Claims is set forth in the Appendix.

Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) over Chen, et al., U.S. Patent No. 5,990,377 in view of Applicant's admission further evidenced by Müller, GB Patent No. 2,376,436 A; Roussel, et al., International Publication No. WO 99/45205; Hein, et al., U.S. Patent No. 5,863,107 B2; or Kamps, et al., U.S. Patent No. 5,702,571.

Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) over Luu, et al., U.S. Patent No. 6,352,700 in view of Kamps, et al., U.S. Patent No. 5,702,571.

IV. Status of the Amendments

No amendments to the instant claims have been filed by Appellants in response to the Final Office Action dated May 9, 2006. No amendments to the claims have been filed after receipt of the Advisory Action dated June 23, 2006.

V. Summary of the Claimed Subject Matter

According to independent Claim 1, a method for making a tissue paper from a tissue paper web comprises the steps of passing the tissue paper web through an embossing nip formed between a first and a second embossing roll and applying a transferable lotion to at least portions of the tissue paper web. (6:23-25; 8:16-17) At least one of the embossing rolls comprises at least thirty embossing elements per square centimeter. (7:4-7) The transferable lotion is applied to the tissue paper web so that the tissue paper product is adapted to transfer a first quantity of the transferable lotion upon stationary contact with a glass surface and transfer a second quantity of the transferable lotion upon dynamic contact with a glass surface. (9:4-8; 10:11-14) The second quantity is at least two times greater than the first quantity. (10:11-14)

Claim 2 requires the step of the embossing roll comprising at least fifty embossing elements per square centimeter. (7:5)

Claim 3 requires the embossing elements to have a height of less than 0.5 mm. (7:10)

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Claim 4 requires the first embossing roll to have a web contacting surface comprising a rubber material and the second embossing roll to have a web contacting surface comprising a hard material. (7:21-25)

Claim 5 requires that the step of applying a lotion to at least portions of the tissue paper web is carried out after the step of passing the tissue paper web through the embossing nip. (8:16-17)

Claim 6 further comprises the step of cutting the sheets to provide paper tissue products. (13:1-3)

Claim 7 provides for a tissue paper product made according Claim 1. (10:17-20; generally)

VI. Grounds of Rejection to Be Reviewed on Appeal

1.   Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) over Chen, et al., U.S. Patent No. 5,990,377 in view of Appellants' admission further evidenced by Müller, GB Patent No. 2,376,436 A; Roussel, et al., International Publication No. WO 99/45205; Hein, et al., U.S. Patent No. 5,863,107 B2; or Kamps, et al., U.S. Patent No. 5,702,571.

2.   Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) over Luu, et al., U.S. Patent No. 6,352,700 in view of Kamps, et al., U.S. Patent No. 5,702,571.

VII. Argument

As set forth below, the invention defining the appealed claims is unobvious over the cited references under 35 U.S.C. §103(a). Therefore, all rejections to the claims under 35 U.S.C. §103(a) should be reversed.

A.   Claims 1-7 Are Unobvious Over *Chen* In View of Appellants' Admission *Müller, Rousse, Hein, and Kamps*.

Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) over Chen, et al., U.S. Patent No. 5,990,377 (the '377 reference) in view of Appellants' admission further evidenced by Müller, GB Patent No. 2,376,436 A (the '436 reference); Roussel, et al., International Publication No. WO 99/45205 (the '205 reference); Hein, et al., U.S. Patent No. 5,863,107 B2 (the '107 reference); or Kamps, et al., U.S. Patent No. 5,702,571 (the '571 reference). The '377 reference teaches a dual-zoned, three-dimensional resilient absorbent web suitable for use as a body side liner for absorbent articles, such as feminine pads, diapers, and the like. (Abstract) The '377 reference discloses that aqueous emulsions and emulsifiable compositions may be used for coating paper and the like. (35:25-43)

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Ostensibly, the hydrophic matter is applied in a manner designed to limit lateral (in-plane) wicking of liquids to prevent seepage or leakage from the edges of an absorbent article while also improving the dry feel. (33:4-8) While other aqueous emulsions and emulsifiable compositions can be applied to [a substrate], "[t]he hydrophobic matter may also comprise formulations intended to *promote skin wellness and comfort.*" (35:25-34; emphasis added) Thus, it is abundantly clear that the *Chen* reference desires to provide a comfortable feel to the resulting absorbent web but does not contemplate transference of such products from the treated web to the user.

The Examiner asserts that, ". . . the tissue of the combination of references, as cited in the previous action, would *inherently* have the same properties of the claimed tissue."[1] Additionally, the Examiner asserts that, [t]he embossing as taught by the secondary references would *inherently* impart the same properties to the paper of the primary reference(s)."[2] Appellants are at a loss to understand 1) how the combination of references cited by the Examiner "inherently" provides the same properties of Appellants' claimed invention, and 2) how inherency can make Appellants' claimed invention obvious. This is simply not the legal test for obviousness under settled Federal Circuit case law.

A proper obvious analysis under 35 U.S.C. §103(a) requires, *inter alia,* the consideration of two factors: 1) whether the prior art would have *suggested* to those of ordinary skill in the art that they should make the claimed composition or device or carry out the claimed process; and 2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success.[3] Without some disclosure, teaching, or suggestion, there is no factual or legal basis that supports the Examiner's position.

In following the *Noelle* test, the disclosures of the secondary references cited by the Examiner do nothing and, in fact, do not even provide for a modicum of a suggestion or motivation to provide for Appellants' claimed method for making a tissue. Nowhere within the *Chen* reference is there a suggestion to provide a composition disposed within the substrate to transfer a first quantity of the composition upon stationary contact with a glass surface and transfer a second quantity of the composition upon dynamic contact with a glass surface. The *Chen* reference is an absorbent article and indeed does not even contemplate

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[1] May 9, 2006 Office Action, p. 2; emphasis added
[2] *Id.;* emphasis added
[3] *See Noelle v. Ledderman,* 355 F.3d 1343, 69 U.S.P.Q. 2d 1508 (Fed.Cir. 2004); emphasis added

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such transference, as required by Appellants' claimed invention. Any transference of a substance from a *Chen* treated web would likely be undesirable. The *Chen* web seeks to absorb; not transfer. The cited secondary references do nothing to cure these defects.

Assuming, *arguendo*, that one could even combine the *Chen* and all the secondary references, they do not teach Appellants' claimed invention. This is because none of the references discloses, teaches, or even remotely suggests a method for making a tissue paper product from a tissue paper web, as claimed by Appellants. The Examiner has provided no clear and particular suggestion of combinability within any of the cited references that would render Appellants' Claims 1-7 obvious.

Appellants respectfully believe that the '377 reference, in view of the cited secondary references, does not teach, disclose, or even remotely suggest each and every element of Appellants' claimed invention. In particular, the combination of the '377 reference and the cited secondary references do not disclose or suggest Appellants' claimed method for making a tissue paper product from a tissue paper web. Accordingly, the rejection of the instant claims under 35 U.S.C. §103(a) over the '377 and the cited secondary references should be withdrawn.

B.   <u>Claims 1-7 Are Unobvious Over *Luu* In View of *Kamps*.</u>

Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) over Luu, et al., U.S. Patent No. 6,352,700 (the '700 reference) in view of Kamps, et al., U.S. Patent No. 5,702,571 (the '571 reference). The Examiner indicates that, "As to the transfer of the lotion, one of ordinary skill in the art would have expected similar ratio as claimed."[4] "Applicants examples demonstrate that the same claimed ratio of lotion is transferred irrespectively if the tissue is embossed or not [thus] clearly [showing] that the dynamic transfer is more that [*sic*] double of the static transfer, 21.83% vs. 5.14%."[5] The Examiner concludes that, "One of ordinary skill in the art would expect at least [*sic*] if the tissues of the primary references were embossed as suggested by the secondary references."

Again, the Examiner has not provided any teaching or suggestion within the '700 and '571 references with some rational underpinning to support the legal conclusion of obviousness obtained in the instant Application.[6] Using Appellants' disclosure to provide the necessary rationale for an obviousness rejection is impermissible under settled Federal

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[4] May 9, 2006 Office Action, p. 3
[5] *Id.*
[6] *In re Kahn.* Fed. Cir. No. 04-1616, 3/22/06

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Circuit law. "An inventor's explanation of how the invention works does not render obvious that which is otherwise unobvious." (*In re Glaug*, 283 F.2d 1335, 62 U.S.P.Q. 2d 1151 (20020))

In any case, the combination of the '700 and '571 references does not teach, disclose, or even provide for a modicum of suggestion for each and every element of Appellants' claimed invention. In particular, no references cited by the Examiner disclose or provide any motivation or suggestion to teach Appellants' claimed process for making a tissue paper product from a tissue paper web having the required transference capability. Appellants' claimed subject matter is unobvious over the '700 and '571 references, either alone or in combination. Accordingly, the rejection of Claims 1-7 under 35 U.S.C. §103(a) over the '700 and '571 references should be withdrawn.
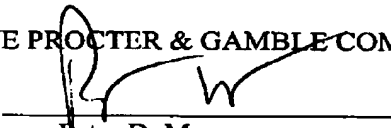
VIII. Conclusion

The Examiner has not satisfied the burden of demonstrating that Appellants' claimed invention is inadequately claimed and/or obvious over the cited references. Specifically, nothing in the cited references, when taken individually or even in combination with Appellants' specification, teaches, discloses, or even remotely suggests Appellants' claimed method for making a tissue paper product from a tissue paper web.

Thus, for the reasons stated above, the Board is respectfully requested to find Claims 1-7 of the instant Application allowable over the references cited by the Examiner.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By _____

Peter D. Meyer
Attorney for Appellants
Registration No. 47,792
(513) 634-7419

September 26, 2006
Customer No. 27752

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CLAIMS APPENDIX

1.   (Rejected) A method for making a tissue paper product from a tissue paper web, said method comprising the steps of:

- passing said tissue paper web through an embossing nip formed between a first and a second embossing roll, wherein at least one of said embossing rolls comprises at least 30 embossing elements per square centimeter; and,

- applying a transferable lotion to at least portions of said tissue paper web such that

said tissue paper product is adapted to transfer a first quantity of said transferable lotion

upon stationary contact with a glass surface and transferring a second quantity of said

transferable lotion upon dynamic contact with a glass surface, wherein said second

quantity is at least 2 times greater than said first quantity.

2.   (Rejected) The method according to claim 1, wherein least one of said embossing rolls comprises at least 50 embossing elements per square centimeter.

3.   (Rejected) The method of claim 1, wherein said embossing elements have a height of less than 0.5 mm.

4.   (Rejected) The method of claim 1, wherein said first embossing roll has a web contacting surface comprising a rubber material and said second embossing roll has a web contacting surface comprising a hard material.

5.   (Rejected) The method of claim 1, wherein in that said step of applying a lotion to at least portions of said tissue paper web is carried out after said step of passing said tissue paper web through an embossing nip.

6.   (Rejected) The method of claim 1 further comprising a step of cutting sheets as to provide paper tissue products.

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7.   (Rejected) A tissue paper product made according to claim 1.

8.   (Cancelled)

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EVIDENCE APPENDIX

N/A

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RELATED PROCEEDINGS APPENDIX

N/A